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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,451	03/30/2004	J. Mark Morrow	031599/260277	3164
826	7590	12/13/2006	EXAMINER	
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000				THAKUR, VIREN A
			ART UNIT	PAPER NUMBER
			1761	

DATE MAILED: 12/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/812,451	MORROW, J. MARK	
	<b>Examiner</b>	<b>Art Unit</b>	
	Viren Thakur	1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-27 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-27 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/30/04</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 22, 24 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. Instant claim 22 recites that the skirt flares outwardly toward a lower end of the skirt. It is not clear as to how an end of a skirt extends both outwardly and toward itself.
- b. Instant claim 24 recites the limitation "at least partway." It is not clear as to how much of the length of the primary container the shrink film should extend across to be considered partway.
- c. Instant claim 26 recites that the shrink band is wrapped about the top ends of the cup holder and the primary container to seal the package and further recites that the cup holder remains open at the top end. If the top end of the cup holder remains open at the top end, then the shrink band cannot also be wrapped about the top end of the cup holder. If the shrink

wrap extends into the cup holder, then the top end of the cup holder is not covered.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-10, 14-17, 19-21 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Muraoka (US 4018904). Muroaka discloses a package for containing a food product (Figure 1) that is prepared for consumption by mixing with liquid, the package serving as a vessel for the preparation as well as a container in which the prepared food product is served (Column 1, Lines 6-11), the package comprising: a primary container (Figure 1, Item 2) comprising a tapered plastic cup (Column 2, Lines 33-36) having a radially outwardly projecting rim at a top end of the cup (Figure 1, Item 12); and a cup holder (Figure 1, Item 3) comprising a tapered plastic cup (Column 2, Lines 57-58) having a radially outwardly projecting flange at a top end thereof (Figure 1, Item 18) and an elongated skirt depending from the flange (Figure 1, Not Labeled – See downwardly point skirt next to Item 18) such that a channel (Figure 1, See

Next to Item 12) is defined between the skirt and a side wall of the cup holder.

Regarding the nestability of the cup holder and the outer container, Muraoka discloses a cup holder that is nested within an outer container by "snugly receiving the cup holder within the outer container." The cup holder and the outer container are not sealed together and as can be seen by Figure 1, both the cup holder and the primary container contain a congruency that would allow the primary container to be nested within the cup holder; thus said cup holder and primary container are configured to and capable of being nested reversibly. The structure of the cups as shown in Figure 1 demonstrate that said cups can be nestable within each other. Nevertheless, this is the intended use of the invention which is met if the prior art recites the structural limitations of the claim. Regarding instant claim 2, Muraoka discloses the package of claim 1, further comprising complementary locking features on the cup holder (Figure 1, Item 16 and 17) and primary container (Figure 1, Item 8 and 10) for locking the primary container into the cup holder in the serving configuration of the package. Since said cups are configured to be nestable within each other and contain locking features, said cups are capable of locking in the serving configuration of the package. This is an intended use that is met by meeting the structural limitations. Regarding instant claim 3, Muraoka discloses the package of claim 2, wherein the locking features comprise a projection formed on one of the cup holder (Figure 1, Item 16 and 17) and primary container and a recess (Figure 1, Item 8 and 10) formed on the other of the cup holder and primary container, the

projection engaging the recess in the serving configuration. Regarding instant claim 4, Muraoka discloses the package of claim 3, wherein the recess is formed in an inner surface of the cup holder (Figure 1, Items 16 and 17) and the projection is formed on an outer surface of the primary container (Figure 1, Items 8 and 10). Since both said cups comprise projections the opposite side of each projection is a recession; therefore, depending on the configuration both cups recite a projection and a recession in the same location. Regarding instant claim 5, Muraoka discloses, the package of claim 4, wherein the recess comprises a groove extending circumferentially about the inner surface of the cup holder (Figure 1, See circumferential recess in near item 16 and 17), and the projection comprises a raised region extending circumferentially about the primary container (Figure 1, See circumferential projection near item 8 and 10).

Regarding instant claim 6, Muraoka discloses the package of claim 5, wherein the cup holder includes a second recess (Figure 1, Items 16 and 17), the recesses being axially spaced, and the primary container includes a second raised region (Figure 1, Items 8 and 10), the raised regions being axially spaced.

Regarding instant claim 7, Muraoka discloses, the package of claim 1, further comprising spacing members formed on one of the cup holder (Figure 1, Item 13, 14, 16 and 17) and primary container (Figure 1, Items 7, 8, and 10) for spacing a side wall of the cup holder from a side wall of the primary container in the serving configuration of the package, whereby the cup holder provides thermal isolation from the primary container (Column 3, Lines 21-23). Additionally, the recesses

and projections that lock the cup and primary container in each nesting configuration are also the spacing members a side wall on one of the cup holder and primary container. Furthermore, since the invention of Muraoka comprises cups which are nestable within each other and comprise spacing members that create space between said cups, then said cups are thus capable of creating said spacing when in said serving configuration. Regarding instant claim 8, Muraoka discloses the package of claim 7, wherein the spacing members comprise ribs (Figure 1, Items 13 and 14). As recited in instant claim 9, Muraoka discloses the package of claim 8, wherein the ribs project inwardly from an inner surface of the side wall of the cup holder and abut an outer surface of the side wall of the primary container in the serving configuration (Figure 1, Items 13 and 14). Since the serving configuration is a future state of the package of claim 1, Muraoka discloses a package wherein said cups are nestable within each other, said cups are capable of being configured in the serving configuration. Thus, said ribs of the cup holder will abut the sidewall of the outer container when in said serving configuration. Regarding instant claims 10 and 14, Muraoka discloses the package of claim 1, comprising a food product contained in the package in the packaged configuration (Figure 1, Item A). Regarding instant claims 15 and 16, Muraoka discloses a membrane (Figure 1, Item 4) sealed to the top end of the cup holder (Column 1, Lines 63-66) and further comprising a wrapper wrapped about at least the top ends of the cup holder and primary container in the packaged configuration (Figure 1, Item 5). As recited in instant

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claim 17, Muraoka discloses wherein the wrapper comprises a shrink film (Column 2, Lines 30-33). As recited in instant claim 19, Muraoka discloses wherein the rim of the primary container comprises a flat flange (Figure 1, Item 12), wherein the primary container and cup holder comprise thermoplastic (Column 2, Lines 33-26 and 57-58). Muraoka discloses polystyrene which is a thermoplastic. Regarding instant claim 21 it is known that thermoplastics require thermoforming to take the shape of an object. As recited in instant claim 24, Muraoka discloses a shrink film wrapped about the top ends of the cup holder and primary container, and extending completely around the entire package (Figure 1, Item 5) and further discloses a line of weakness (Figure 1, Item 22) allowing an upper portion of the shrink film to be detached from a lower portion of the shrink film. In removing the top portion of the shrink film, said lower portion of the shrink film is still wrapped around the outer container when said package is converted into the serving configuration.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Tupper (US 2766796). Tupper disclose a package for containing a food product (Figure 4), the package serving as a vessel for the preparation as well as a container in which the prepared food product is served (Column 1, Lines 15-18), the package comprising a primary container (Figure 4, Item 26) comprising a tapered plastic cup (Column 1, Lines 29-40) having a radially outwardly projecting rim (Figure 4, Item 27) at a top end of the cup; and a cup holder (Figure 4, Item 10) comprising

tapered plastic (Column 1, Lines 29-40) having a radially outwardly projecting flange (Figure 4, Item 13) at a top end thereof and an elongated skirt depending from the flange (Figure 4, Item 12) such that a channel is defined between the skirt and a side wall of the cup holder; the cup holder and primary container being complementarily configured to be nestable inside each other such that the package is convertible between a packaged configuration in which the cup holder is nested inside the primary container (Figure 4) and a serving configuration in which the primary container is nested inside the cup holder (Figure 5); the channel of the cup holder being configured to receive the rim of the primary container when the package is in the packaged configuration (Figure 4, Item 27). Regarding instant claim 1, the limitations disclose wherein the package is for containing a food product therefore, since the prior art meets the structural limitations, the prior art is capable of the intended use as recited in the instant claim.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

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Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 11, 12, 18 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muraoka (US 4018904) in view of Syverson et al. (US 3227273). Muraoka disclose as cited above. Regarding instant claim 11, Muraoka discloses wherein the cup holder is shorter than the primary container (Figure 4) such that in the packaged configuration a space is defined between a bottom wall of the cup holder and a bottom wall of the primary container. However, Muraoka is silent in teaching wherein the food product is disposed in said space. Syverson et al. teach wherein the food product is disposed within a space between an inserted cup and the primary cup (Figures 3 and 4, Item 12). The space between the insert and the primary cup stores the dry food product and protects the dry food product from contamination. Thus Syverson et al. provide evidence that it would have been known to one having ordinary skill in the art to position the food product between two nested cups. Nevertheless, Muraoka also teach wherein the entire package is wrapped so as to create a hermetic seal to protect the food product. Given these teachings, the position of

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the food product would have been a change in location for providing the equivalent function of protecting the food product, and thus would not have provided an inventive step over the prior art.

Regarding instant claim 12, Muraoka discloses a wrapper wrapping about at least the top ends of the cup holder and primary container in the packaged configuration.

Regarding instant claim 13, Muraoka discloses wherein said wrapper is a shrink film (Column 2, Lines 30-33).

Regarding instant claim 18 Muraoka discloses as cited above. Muraoka further discloses adding water to a dry "instant food" so as to rehydrate the dried food (Column 3, Lines 31-36). Muraoka is silent in teaching wherein the food product comprises a dry beverage mix. Syverson teaches nestable cups that contain a dry beverage stored between said cups wherein said dry beverage is rehydrated with water to form the beverage (Column 1, Line 69 to Column 2, Line

5) Although Muraoka only teach an example comprising soup, it would have been obvious to one having ordinary skill in the art that a soup is both eaten and drunk. The broth that forms as a result of adding the water is a beverage. Since Syverson teaches providing a dry beverage powder within a food package comprising two cups (Column 1, Line 70 to Column 2, Line 2), the concept of adding a dried product in a cup that requires water to rehydrate form the food product is a known concept regardless of the type of product to be rehydrated.

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9. Claims 22, 23, 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muraoka (US 4018904). Muraoka teach as cited above.

Regarding instant claims 22 and 23, Muraoka is silent in teaching wherein the skirt is flared radially outwardly toward the lower end of the skirt and wherein the lower end of the skirt includes a radially outwardly projecting flange. However, the skirt and radially extending flange at the lower end of the skirt of Muraoka perform similar functions as that of the Applicant's invention. It would have been obvious to one having ordinary skill in the art that extending skirt structures would assist the consumer in disengaging the cup holder from the outer container, since the extension of the skirt structures provides a greater area that the user can grasp the cup holder so as to remove it from its nested position; therefore changing the direction does not change the function and would not provide an inventive step over the prior art.

Regarding instant claim 25, Muraoka is silent in teaching printing of visual elements; however the invention of Muraoka discloses visual elements. Adding printed material onto the package is merely an aesthetic design change, which would not provide a patentable feature over the prior art. (See MPEP 2144.04) Nevertheless, printing visual elements to the food package of Muraoka would have been obvious for the purpose of promoting the package and making said package visually appealing to the consumer.

Regarding instant claim 27, Muraoka teach as cited above. Muraoka also teaches wherein the synthetic resin used to form the cups should not be

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deformable by hot water (Column 2, Lines 33-36). The examiner also notes that Muraoka teaches polystyrene as an example of a synthetic resin used to form the cups.

Syverson teaches as cited above and additionally that the dehydrated "beverages such as coffee, tea and chocolate are powdery or granular and are characterized by an attraction for moisture whereby, when exposed to the atmosphere or water vapor, they absorb the moisture to form a liquid or sticky mass." (Column 1, Lines 69 to Column 2, Line 2). Similar to Muraoka who uses a heat shrink film and a hermetically sealed covering (Figure 1, Item 4) which preserve and protect the instant food within the container, Syverson recognized the problem of requiring a moisture barrier to maintain the dry state of the beverage, and further attempted to solve the problem by using cups coated with plastic that form a water tight seal between the two cups (Column 2, Lines 18-19), and vacuum sealing and heat shrinking a film to wrap the entire package to prevent the entry of moisture. Therefore, given the teachings of Syverson it would have been obvious to modify Muraoka as taught by Syverson to use a material for the cups that prevents moisture from entering the package. Such a modification prevents water vapor from entering the package during storage from becoming a sticky mass and becoming hardened as a result. Furthermore, using a non-deformable plastic provides motivation to one having ordinary skill in the art to use a moisture barrier material so as to prevent the heat and vapor of the hot water from absorbing into the cup so as to degrade the structure of the cup.

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Additionally, it would have been obvious to use a moisture barrier material for the invention of Muraoka because using a moisture absorbent material for cups that hold hot food products will result in the eventual degradation of the cup itself. If the material used for the cup absorbs moisture the user would not be able to hold a hot beverage without burning his hand.

10. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Muraoka (US 4018904) in view of Lucas (4134492). Muraoka teach as cited above.

Regarding instant claim 26, Muraoka is silent in teaching wherein a shrink band terminating at an upper edge proximate the flange at the top end such that the cup holder remains open at the top end.

Lucas discloses a coffee cup and container comprising a beverage concentrate (Figure 1, Item 16) wherein the concentrate produces the beverage through the addition of water (Column 2, Lines 10-16). Additionally, Lucas teaches wherein the concentrate can include soups, soft drinks and any other food product that becomes consumable upon being mixed with hot or cold water. The invention of Lucas further comprises a heat sealed lining (Figure 1, Item 14) that terminates at an upper edge of the cup so as to permit the nesting of a second food package therein. Nevertheless, nesting is a common storage means recognized by one having ordinary skill in the art. *For example,* On Column 1, Lines 5-38, U.S. Patent 5938015 to Candy provides further support for sealing a food product container similar to Lucas and Muraoka within the confines of the cup so as to allow for more efficient storage.

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Both Lucas and Muraoka provide a sealing liner for protecting a food package. Moving the sealing means within the cup would have allowed for nested compact storage, which was a well known storage technique to one having ordinary skill in the art. Thus, it would have been obvious to modify Muraoka to provide the lining that protects the food package within the confines of the cup as taught by Lucas so as to allow for more efficient storage of the food package.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 5897019, US 4865199, US 3246786 discloses a beverage cup and lid nested therein, wherein the cup is nestable within the lid. US 4865199 and US 6562270 discloses a combination cup insulator and stabilizer wherein the insulator/stabilizer is nested within the cup. US 4232502 discloses a beverage concentrate in a cup and a removable vacuum seal wrapping to protect said cup. US 5938015 discloses a sealing means disposed within a cup comprising a beverage concentrate.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Viren Thakur whose telephone number is

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(571)-272-6694. The examiner can normally be reached on Monday through Friday from 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571)272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Viren Thakur  
Examiner  
Art Unit: 1761

  
KEITH HENDRICKS  
PRIMARY EXAMINER